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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 10/028,718
Filing Date: December 28, 2001
Appellant(s): MARKARIAN ET AL.

John M. Harrington
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 04/26/2008 appealing from the Office action

mailed 10/31/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial

proceedings which will directly affect or be directly affected by or have a bearing on the

Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection

contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is

correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US 2005/0027610 A1	Wharton	Feb. 3, 2005
US 6,965,868 B1	Bednarek	Nov. 15, 2005

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 12 and 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wharton (US 2005/0027610) in view of Bednarek (US 6,965,868).

Wharton teaches a method and system for dynamically converting data between a mobile station in a wireless communication network and an origin server in a wide area network, comprising:

Claims 12 and 14-18,

sending from a customer device a Wireless Markup Language (WML) encoded URL request for a resource; receiving said request at a gateway server and re-formatting said request into HTML format; communicating said re-formatted request to a particular resource information on the World Wide Web, and receiving the requested resource information at said gateway; parsing said received resource information and re-formatting the processed information into WML encoded message to transmit it back to the customer device; sending a purchase request to a merchant website; sending a purchase request response, including a payment authorization request, from the merchant website to a payment authorization system; and transmitting said purchase request response to the customer device (Figs. 1 and 4); [0009]; [0011]; [0026]; [0046]; [0051]; [0053].

While Wharton teaches that said arrangement is implemented in a wireless network, Wharton does not specifically teach the customer device is a *mobile* device.

Bednarek teaches a method and system for promoting e-commerce, wherein a merchant sells goods or services using a website, and a customer communicates with the merchant via a customer *mobile* device, and wherein data transmitted between the merchant and the customer *mobile* device is converted by the server to a format that can be displayed on the customer *mobile* device (C. 68, L. 65 – C. 69, L. 15; C. 70, L. 45-52).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Wharton to include that communication with the customer is conducted by means of customer mobile device, as disclosed in Bednarek, because it would advantageously allow to provide the customer with information correlated to the customer current cellular position, such as gas stations, hotels, restaurants and grocery stores, as specifically stated in Bednarek, thereby providing convenience to the customer. Furthremore, Supreme Court Decision in *KSR International Co. v. Teleflex Inc.* (KSR, 82 USPQ2d at 1396) forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness. See the recent Board decision Ex arte Smith, --USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007).

(10) Response to Argument

(10.1)   Claims 12 and 18 (Brief, Page 6)

Applicant argues that Wharton does not teach:

(a) transmitting in a first language a request message for merchant website information from a device, (b) receiving the request message at a platform, identifying the first language, translating the request message to a second language recognizable

by a merchant website, and communicating the translated request message in the second language from the platform to the merchant website, and (c) receiving at the platform the requested merchant website information from the merchant website in the second language, recognizing the second language at the platform, parsing the requested merchant website information in the second language into translatable pieces, translating the translatable pieces of the requested website information into the first language to form a reply message containing the requested merchant website information in the first language, and transmitting the reply message to the mobile device.

In response to this argument, it is noted that Wharton discloses (Fig. 1): a customer device (item 42), and a platform (E-commerce portal 32) coupled to a plurality of vendor commerce systems, wherein E-commerce architecture could be implemented via a wireless data network [0022], thereby suggesting a mobile customer device. In operation, a customer request is recognized at the platform, and rooted to an appropriated vendor's Web site to present an appropriate vendor's catalog to the customer [0009]; [0011]; [0026]. Furthermore, Wharton teaches that information (purchase-related) transmitted to the customer device 42 is in a format that is compatible with the customer purchasing software system [0046, fifth line from the bottom], thereby indicating "translation" steps.

Bednarek discloses: a customer mobile device (cell phone 530; Fig. 7), and a platform (Mobile Exchange central server 505) coupled to a plurality of vendor/merchant commerce systems (Fig. 6). In operation, the platform receives customer request from the customer mobile device, and then retrieves appropriate information from a merchant information database Web site (503) and transmits said information back to the customer mobile device (C. 68, L. 48-50, 65-66; C. 70, L. 45-52). Bednarek further teaches, that data pertaining to each merchant must be stored in a format or converted by the server to a format that can be sent to and displayed on the customer mobile device (C. 69, L. 5-8).

(10.2)   Claims 12 and 18 (Brief, Page 6)

Applicant argues that Wharton does not teach:

transmitting a purchase request in response to the reply message in a first language to the platform, receiving the purchase request at a platform and identifying the first language, translating the purchase request at the platform from the first language to a second language that is recognizable by the merchant website, and communicating the translated purchase request in the second language from the platform to the merchant website.

In response to this argument, it is noted that Wharton discloses (Fig. 1): the customer device (item 42), and the platform (E-commerce portal 32) coupled to a plurality of vendor commerce systems, wherein E-commerce architecture could be implemented via a wireless data network [0022]. In operation, a customer purchase request is recognized at the platform, and rooted to an appropriated vendor's Web site to present an appropriate vendor's catalog to the customer [0009]; [0011]; [0026], [0039], wherein purchase-related information transmitted to the customer device 42 is in a format that is compatible with the customer purchasing software system [0046, fifth line from the bottom], thereby suggesting "translation" steps.

(10.3)   Claims 12 and 18 (Brief, Page 7)

Applicant argues that Wharton does not teach:

receiving at the platform a purchase request response including a payment authorization request from the merchant website in the second language, forwarding the purchase request response in the second language from the platform to a payment authorization system for a payment authorization response.

In response to this argument, it is noted that Wharton discloses a plurality of
payment verification systems 22, 24 (fig. 1) which are interfaced to the platform 32 for
authenticating transaction requests [0009]; [0013]. Wharton specifically teaches
incorporating integrated software programming for interfacing, managing and
communicating with the back-end E-Commerce elements that provide payment
verification and accounting/billing processing functions, so that these functions do not
need to be implemented at each of the vendor commerce systems 34, 36, 38 [0029].
Furthermore, Wharton points out that:

"This integrated software programming may take the form of a *common
application programming interface* ("API") that can be scaled to connect the ICC
transaction processor 12 to numerous other systems and services as required. By
using this common API as a means for controlling the back-end processing functions,
as new systems or back-end functions are added to the E-Commerce framework, they
can *simply be plugged into the appropriate software hooks of the API.* In this
manner, as these new systems or functions are added to the common API
interface, they become available to all of the vendor commerce systems 34, 36,
38 that are coupled to the ICC transaction processor 12." [0029].

It is clear from this paragraph that the merchants systems and payment
authorization system are compatible, and communicate to each other in the same
format/language.

(10.4)   Claims 12 and 18 (Brief, Page 7)

Applicant argues that Wharton in view of Bednarek does not teach:

receiving at the platform the purchase request response including the payment
authorization response in the second language from the payment authorization system,
parsing the purchase request response in the second language into translatable pieces,
translating the translatable pieces of the purchase request response into the first
language so as to form a purchase request response in the first language, and
transmitting the purchase request response in the first language to the device.

In response to this argument, it is noted that Wharton discloses these features. Specifically, Wharton teaches the plurality of payment verification systems 22, 24 (fig. 1) which are interfaced to the platform 32 for authenticating transaction requests [0009]; [0013]. Wharton specifically teaches incorporating integrated software programming for interfacing, managing and communicating with the back-end E-Commerce elements that provide payment verification and accounting/billing processing functions, so that these functions do not need to be implemented at each of the vendor commerce systems 34, 36, 38 [0029]. Wharton further teaches that purchase-related information transmitted to the customer device 42 is in a format that is compatible with the customer purchasing software system [0046, fifth line from the bottom], thereby suggesting "translation" steps.

Bednarek discloses E-commerce arrangement wherein the customer conducts e-shopping via the mobile device, and wherein information including purchase-related data communicated between the platform/server and the mobile device is converted by the platform/server to the format that can be sent to and displayed on the customer mobile device (C. 69, L. 5-8).

(10.5)   Claims 12 and 18 (Brief, Page 8)

Applicant argues that Bednarek does not teach:

(a) transmitting in a first language a request message for merchant website information from a mobile device, (b) receiving the request message at a platform, identifying the first language, translating the request message to a second language recognizable by a merchant website, and communicating the translated request message in the second language from the platform to the merchant website, and (c) receiving at the platform the requested merchant website information from the merchant website in the second language, recognizing the second language at the platform, parsing the requested merchant website information in the second language into translatable pieces, translating the translatable pieces of the requested website

information into the first language to form a reply message containing the requested merchant website information in the first language, and transmitting the reply message to the mobile device.

In response to this argument, it is noted that Wharton was applied for these features (See a discussion above, 10.1). Bednarek was applied for the use of the mobile device in E-commerce applications, wherein data communicated between the mobile device and the platform/server is converted by the platform/server to the format that can be displayed on the customer mobile device (C. 69, L. 5-8). At this end the examiner points out that Applicant argues against the references individually, but one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

(10.6)   Claims 12 and 18 (Brief, Page 8)

Applicant argues that Bednarek does not teach:
receiving at the platform the purchase request response including the payment authorization response in the second language from the payment authorization system, parsing the purchase request response in the second language into translatable pieces, translating the translatable pieces of the purchase request response into the first language so as to form a purchase request response in the first language, and transmitting the purchase request response in the first language to the mobile device.

In response to this argument, it is noted that Wharton was applied for these features (See a discussion above, 10.4). Bednarek was applied for the use of the mobile device in E-commerce applications, wherein data communicated between the mobile device and the platform/server is converted by the platform/server to the format that can be displayed on the customer mobile device (C. 69, L. 5-8). The examiner

maintains that Applicant argues against the references individually, but one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

(10.7)   Claims 12 and 18 (Brief, Page 10)

Applicant argues that the examiner's conclusion of obviousness is based upon improper hindsight reasoning.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case both references disclose conducting E-commerce wherein the customers access merchants Web pages via wireless communication systems in platform independent environment. Modifying Wharton to include the mobile device would benefit the customers (adding convenience) by providing them with information correlated to the customer current geographical/cellular position, such as gas stations, hotels, restaurants and grocery stores, as specifically stated in Bednarek.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the

Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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